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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,762	05/01/2001	Robert Shea	31910.000014	5008

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EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT PAPER NUMBER

3726

DATE MAILED: 08/14/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/846,762

Applicant(s)

SHEA ET AL.

Examiner

Marc Jimenez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4,6,8-14 and 26 is/are pending in the application.
- 4a) Of the above claim(s) 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,6 and 8-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)):
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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## DETAILED ACTION

### *Response to Amendment*

1. The reply filed on 7/3/03 is not fully responsive to the prior Office Action because:

Applicant has amended the claims such that the claims are now directed to “a roller **assembly**” instead of the originally presented claims directed to “a roller”. Applicant must rewrite the claims such that the claims are directed to “a roller” rather than the “roller assembly”. For example, “a first shaft” as recited in line 3 of claim 1 should read - - a shaft - -.

The amendment filed 7/3/03 does not comply with current amendment practice because in claim 1, line 2: “the roller assembly comprising” should have been written as - - the roller assembly comprising - -. In claim 4, line 2 “open cell cellular” should have been written as - - open cell cellular - -. The newly added limitation was not indicated as being added by underlining the text. Applicant is requested to check that proper amendment practice is followed in subsequent amendments to avoid a non-compliant letter from the PTO.

On page 2 of the amendment filed 7/3/03 requested a change to page 6 of the specification, however, there are no lines 158-172 in the specification. Therefore the amendment to the specification has not been entered.

2. Newly submitted claim 26 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the originally presented invention was directed to a roller whereas newly presented claim 26 is directed to the roller assembly.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 26 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1 and 11** are rejected under 35 U.S.C. 102(b) as being anticipated by Gehrer (2,761,547).

Gehrer teaches a first shaft 1', and at least one tire 2' mounted relative to the shaft 1', each tire 1' being adapted to contact an opposed surface to create a nip therebetween and the shaft 1' being spaced from the opposed surface a distance that is less than the diameter of the tires 2' to create an off set distance, each tire 2' including: a compliant core 6' affixed relative to the shaft 1' for rotation with the shaft 1', the compliant core 6' continuously deforming during rotation to accommodate the offset distance, and a non-compliant outer layer 5' connected to the core 6' for rotation with the core 6', the circumference and diameter of the outer layer 5' remaining constant as the outer layer rotates against the opposed surface to create the nip. It is noted that Gehrer meets the claim limitation "continuously deforming during rotation" because if

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the roll is forced onto a surface the compliant core 6' will deform as the outers surface 5' which is made of a metal tube retains its constant tubular shape. Therefore, Gehrer inherently meets the "continuously deforming" limitation. It is noted that Gehrer teach each of the claimed structural features of applicant's roll. The "continuously deforming during rotation" is an intended use recitation, and a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 11, the non-compliant layer 5' includes a metal tube (col. 2, lines 61-65).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 4 and 6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gehrer in view of Matson (3,866,716).

Gehrer teaches the invention cited with the exception of the core being a cellular

structure that is made of polyurethane.

Matson teaches that it is well known in the art to use a cellular structure made of polyurethane for a core (col. 3, lines 16-34).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Gehrler with a cellular core structure, in light of the teachings of Matson, in order to provide a compressible, light weight, core material.

At the time of the invention, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have used an open cell structure because applicant has not disclosed that using an open cell structure provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either the closed cell structure taught by Matson, or the claimed open cell structure, because both cell structures perform the same function of providing an elastic layer equally well. Therefore, it would have been an obvious matter of design choice to modify Gehrler/Matson to obtain the invention as specified in claim 4. Furthermore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have selected the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

7. **Claims 8-10** are rejected under 35 U.S.C. 102(b) as anticipated by Gehrler alone or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gehrler in view of Blackwood-Murray et al. (4,440,295).

It is inherent that Gehrer teaches using a non-compliant layer with the claimed durometers because Gehrer uses the same material that applicant claims (ie. metal tube).

Alternatively, Blackwood-Murray et al. teach a non-compliant layer having a durometer between 35 and 60 Shore A.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Gehrer with a non-compliant layer having a durometer between 35 and 60 Shore A, in light of the teachings of Blackwood-Murray et al., in order to provide a surface that has a better gripping surface.

Furthermore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have selected the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

8. **Claims 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over Gehrer in view of Sawa et al. (5,553,845).

Gehrer teaches the invention cited with the exception of having a coefficient of friction material.

Sawa et al. teach a coefficient of friction (abstract, lines 1-2) enhancing material **7** on a tube **4**.

It would have been obvious to one of ordinary skill in the art, at the time of the invention,

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to have provided the invention of Gehrер with a coefficient of friction layer, in light of the teachings of Sawa et al., in order to provide a surface which has good friction and is not affected by changes in temperature or humidity as suggested by Sawa et al., see abstract, lines 1-3.

9. **Claim 13** is rejected under 35 U.S.C. 103(a) as being unpatentable over Gehrер in view of Eiji (JP 08169573).

Gehrер teaches the invention cited with the exception of the non-compliant layer being made of a plastic tube.

Eiji teaches a layer of plastic **3b** over a foam layer **3a**.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Gehrер with a plastic tube, in light of the teachings of Eiji, in order to provide a rust proof tube.

10. **Claim 14** is rejected under 35 U.S.C. 103(a) as being unpatentable over Gehrер in view of view of Eiji as applied to claim 13 above, and further in view of Sawa et al.

Gehrер/Eiji teaches the invention cited with the exception of having a coefficient of friction material.

Sawa et al. teach a coefficient of friction (abstract, lines 1-2) enhancing material **7** on a tube **4**.

It would have been obvious to one of ordinary skill in the art, at the time of the invention,



to have provided the invention of Gehrер/Eiji with a coefficient of friction layer, in light of the teachings of Sawa et al., in order to provide a surface which has good friction and is not affected by changes in temperature or humidity as suggested by Sawa et al., see abstract, lines 1-3.

*Response to Arguments*

11. Applicant's arguments filed 7/3/03 have been fully considered but they are not persuasive.

12. Applicant argues that Gehrер does not teach the recited limitation that the space between the shaft and opposed surface "is less than the **diameter** of the tires to create an off set distance". However, in fig. 1 of Gehrер it is clear that the space between the shaft 1 and an opposed surface, for example the surface that would contact near lead lines 2, is less than the diameter of the tires 2 to create an off set distance. The diameter of the tires always larger than the distance between the shaft and an opposed surface.

13. Applicant argues that Gehrер does not disclose a nip and offset distance, however, the nip and offset distance are only formed when a force is acted on the roller. The structural limitations of the claimed roller is met by Gehrер. In fig. 2 of applicant's specification, there are no forces that act on the roller. Fig. 2 of Gehrер is similar to fig. 2 of applicant's specification. The offset is only created when the roller is acted upon by an external force. Therefore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative

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difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Gehrer is clearly capable of creating a nip and an offset when a force is applied to deform the compliant layer 6'.

14. The design choice rejection regarding the use of open cell structures versus closed cell structures is maintained because there is no evidence of unexpected results or benefits attained by using open cell versus closed cell structures.

15. The rubber of the Japanese publication is still a plastic tube.

16. The suggestion and motivation for the secondary references are in the rejections above.

#### ***Conclusion***

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Interviews After Final***

18. Applicant note that an interview after a final rejection will not be granted unless the intended purpose and content of the interview is presented briefly, in writing (the agenda of the interview must be in writing) to clarify issues for appeal requiring only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations will be denied. See MPEP 714.13 and 713.09.

***Contact Information***

19. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is **703-306-5965**. The examiner can normally be reached on **Monday-Friday, between 5:30 am- 2:00 pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 308-6789 or (888) 786-0101
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MJ

August 13, 2003

  
JOHN C. HONG  
PATENT EXAMINER